

**REMARKS**

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-32 remain pending. Claims 1, 10, 16, 20, and 29 are independent.

**INTERVIEW CONDUCTED**

Applicants thank the Examiner for conducting an interview with Applicants' representative on November 1<sup>st</sup> and 3<sup>rd</sup>, 2005.

**§ 102 REJECTION – GARFINKLE**

Claims 1-4, 7-19, 20 and 29 stand rejected under 35 USC 102(b) as allegedly being anticipated by Garfinkle et al. (USP 6,017,157). Applicants respectfully traverse.

For a Section 102 rejection to be proper, the cited reference must teach or suggest each and every claimed element. *See M.P.E.P. 2131; M.P.E.P. 706.02.* Thus, if the cited reference fails to teach or suggest one or more elements, then the rejection is improper and must be withdrawn.

During the interview, it was demonstrated Garfinkle teaches, at best, utilizing separate processes for uploading (Upload Interface A) images to the image server and to order prints (Interface B). Therefore, Garfinkle cannot teach or suggest the feature of transmitting the designated print-order acceptor

information and at least a part of said digital image data at the same time to the order receiving server as featured in claim 1. This is sufficient to distinguish claim 1 from Garfinkle.

Independent claim 10 recites, in part “transmit said image data and said designated print-order acceptor information at the same time to said order receiving server”; independent claim 16 recites, in part “to transmit said digital image data and said designated print-order acceptor information at the same time to said order receiving server”; independent claim 20 recites, in part “to transmit print request data, the requested service shop data, and the image data at the same time to the selected print service receiving server”; and independent claim 29 recites, in part “the service shop data and the image data are transmitted at the same time in the print request by the terminal.” Clearly, Garfinkle cannot teach or suggest at least these features.

The claims are distinguishable for other reasons as well. For example, independent claim 1 recites, in part “when the recording medium, storing a digital image data, a server-connection address information, and a designated print-order acceptor information, is mounted to the terminal unit, said terminal unit is connected to said order receiving server ... so as to transmit said designated print-order acceptor information and at least a part of said digital image data to said order receiving server” and “said order receiving server outputs a print command data based on the received digital image data,

and a command data by which a receiver of an order in accordance with said designated print-order acceptor information can receive an image print that is printed based on said print command data.”

As recited, when the recording medium is mounted on the terminal, the terminal unit – utilizing the information on the recording medium – connects to the order receiving server specified by the server-connection address information in the recording medium. The terminal unit transmits the designated print-order acceptor information and at least some image data to the specified order receiving server.

The specified order receiving server outputs the print command to print the image data received from the terminal unit. The order receiving server also issues the command so that the printed image is delivered to the receiver specified by the designated print-order acceptor information.

In short, all information necessary to generate and fulfill a print order request, including where the printed images are to be delivered, are included in the mounted recording medium.

In the previous Reply filed on May 26, 2005, Applicants argued that Garfinkle cannot be relied upon to teach or suggest at least the feature of the terminal unit transmitting the print-order acceptor information and at least a part the digital image data to the order receiving server when the recording medium – which stores the image data, the server-connection address

information, and the designated print-order acceptor information – is mounted to the terminal unit. Applicants maintain this argument.

Once again, it bears repeating that the information in the recording medium includes the designated print-order acceptor information, which specifies where the printed images are to be received.

In the Response to Arguments section, the Examiner disagrees with the argument presented by Applicants. The Examiner alleges that Garfinkle teaches that an access code can be written as a barcode on a roll of film (relying upon Garfinkle, column 4, lines 14-20) or in the local machine of the photographer (relying upon Garfinkle, column 4, lines 21-23). The Examiner then alleges that access code includes identification of the location of the image server where the images are stored (relying upon Garfinkle, column 4, lines 21-23). Further, the Examiner alleges that the access code includes the store location where the film was received (relying upon Garfinkle, column 4, lines 21-23). Based on these allegations, the Examiner concludes that Garfinkle discloses the invention as recited in independent claim 1.

In other words, the Examiner is alleging that the information contained in the access code of Garfinkle are equivalent to the information stored in the recording medium as recited in claim 1. For example, the Examiner is alleging that the store location information as disclosed in Garfinkle is equivalent to the

designated print-order acceptor information. The Examiner's allegations still fail to anticipate independent claim 1.

The designated print-order acceptor information as recited and the store location information as alleged are entirely different. As recited, the print-order acceptor information designates the delivery location where the printed image may be received. An example of such location is a service shop 3-1 as illustrated in Figure 1 of the present disclosure.

On the other hand, the store location information as alleged is **not** where the printed image will be received. Garfinkle in column 4, lines 60-65 (relied upon by the Examiner) merely states "In addition to the access code, ... store location (where film was received) ... may be assigned and/or collected for each roll of film. This information is transferred to the image server 16 through the upload interface A along with the digital images." In other words, the store location information is merely the source location of the images when they are first uploaded into the image server.

The store location is uploaded along with the image data to the image server. It is noted that the upload interface A is only used to upload images to the image server. The upload interface A is not used to request prints whatsoever. The use of the upload interface A is additional evidence that the store location information is not used to designate the location of the printed image receiver.

Thus, even if it is assumed that the access code as disclosed in Garfinkle includes the store location information as the Examiner alleges, the access code as disclosed in Garfinkle cannot be equivalent to the information stored in the recording medium as recited in claim 1. For this reason alone, the Examiner's Response to Arguments fails.

There are other failures. For example, contrary to the Examiner's allegation, the access code as disclosed in Garfinkle, by itself, is nothing more than a unique association of each image with the location of the image server. *See Garfinkle, column 4, lines 7-10.* However, Applicants do note that Garfinkle indicates along with the access code, other information such as name, phone, email address, store location, etc. are uploaded along with the images through the upload interface A when the images are uploaded. *See Garfinkle, column 57-67.*

As another example of the failure, the access code is **not** written in a bar code of a roll of film as disclosed in Garfinkle. Column 4, lines 14-20 (relied upon by the Examiner) states "The access code may be **selected by the scanner operator** for each roll of film based upon a desired set of criteria." *Emphasis added.* Garfinkle goes on to indicate that the access code may be selected based upon a pre-assigned number of the batch operation and the bar code of the film.

This clearly indicates that the bar code is merely an identification of the film roll itself, such a serial number. The access code is separately created and uploaded on to the image server. Thus, contrary to the Examiner's allegation, Garfinkle does not teach or suggest a recording medium (film roll) as including the server-connection address information and the designated print-order acceptor information.

The above stated reasons are sufficient to distinguish claim 1 over Garfinkle.

There are other distinctions as well. For example, in the Final Office Action, the Examiner alleges that the upload interface A is equivalent to the terminal unit as recited. However, as clearly demonstrated above, the upload interface A is merely used to upload images to the image server. The upload interface A cannot be utilized to print images. Thus, Garfinkle cannot be relied upon to teach or suggest the feature of the terminal unit as recited.

For at least the above stated reasons, independent claim 1 is distinguishable over Garfinkle.

Independent claim 10 recites, in part "A recording medium on which digital image data has been recorded, which can be mounted to a terminal unit connectable to a network, and which stores therein connection address data to a print order receiving server connected to said network, designated print-order acceptor information, and data for causing said terminal unit to connect to

said order receiving server through said network when the recording medium is mounted to said terminal unit and to transmit said image data and said designated print-order acceptor information at the same time to said order receiving server.”

It has been clearly demonstrated above that Garfinkle cannot be relied upon to teach or suggest at least this feature. Therefore, independent claim 10 is distinguishable over Garfinkle.

Independent claim 16 recites, in part “recording connection address data to a print order receiving server connected to a network, designated print-order acceptor information, and data for causing said terminal unit to connect to said order receiving server through said network when the recording medium is mounted to a terminal unit and to transmit said digital image data and said designated print-order acceptor information at the same time to said order receiving server.”

It has been clearly demonstrated above that Garfinkle cannot be relied upon to teach or suggest at least this feature. Therefore, independent claim 16 is distinguishable over Garfinkle.

Independent claim 20 recites, in part “information stored within the recording medium includes connection address data of a selected print service receiving server among the one or more print service receiving servers, requested service shop data, and image data,” “the terminal is configured to



transmit print request data, the requested service shop data, and the image data at the same time to the selected print service receiving server via the network based on the connection address data” and “the selected print service receiving server configured to transmit reception data to a requested service shop corresponding to the requested service shop data to fulfill a print order corresponding to the print request data and the image data transmitted from the terminal.”

It has been clearly demonstrated above that Garfinkle cannot be relied upon to teach or suggest at least these features. Therefore, independent claim 20 is distinguishable over Garfinkle.

Independent claim 29 recites, in part “wherein the print request is generated by the terminal based on information stored in a recording medium mounted on the terminal” and “wherein information stored in the recording medium include connection address data of the print service receiving server, service shop data of the requested service shop, and the image data.”

It has been clearly demonstrated above that Garfinkle cannot be relied upon to teach or suggest at least these features. Therefore, independent claim 29 is distinguishable over Garfinkle.

The following is also noted regarding the Examiner’s rejections. The Examiner relies upon Figure 3 of Garfinkle to allegedly teach/suggest that the terminal transmits the print request data and the image data. However, it is

noted that flow chart of Figures 3, 3A and 3B is exclusively devoted to upload images from a scanner to the image server. Figure 3 is completely silent regarding image print operations, and thus cannot teach or suggest any recited feature of the claims.

Claims 2-4, 7-9, 11-15 and 17-19 depend from independent claims 1, 10 or 16 directly or indirectly. Therefore, for at least the reasons stated with respect to independent claims, these dependent claims are also distinguishable over Garfinkle.

Applicants respectfully request that the rejection of claims 1-4, 7-19, 20 and 29 based on Garfinkle be withdrawn.

§ 103 REJECTION – GARFINKLE, FANNING

Claims 5, 6, 23, 24, 31 and 32 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Garfinkle in view of Fanning et al. (USP 6,742,023). Applicants respectfully traverse.

It is noted that claims 5, 6, 23, 24, 31 and 32 depend from independent claims 1, 20 or 29 directly or indirectly. It has been demonstrated above that claims 1, 20 and 29 are distinguishable over Garfinkle. Fanning has not been, and indeed cannot be relied upon to correct for at least the above-noted deficiencies of Garfinkle. Therefore, independent claims 1, 20 and 29 are distinguishable over the combination of Garfinkle and Fanning. For at least

due to the dependency thereon, claims 5, 6, 23, 24, 31 and 32 are also distinguishable over the combination of Garfinkle and Fanning.

Applicants respectfully request that the rejection of claims 5, 6, 23, 24, 31 and 32 based on Garfinkle and Fanning be withdrawn.

§ 103 REJECTION – GARFINKLE, SUBRAMANIAM

Claims 21, 22 and 30 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Garfinkle in view of Subramaniam et al. (USP 6,081,900). Applicants respectfully traverse.

It is noted that claims 21, 22 and 30 depend from independent claims 20 or 29 directly or indirectly. It has been demonstrated above that claims 20 and 29 are distinguishable over Garfinkle. Subramaniam has not been, and indeed cannot be relied upon to correct for at least the above-noted deficiencies of Garfinkle. Therefore, independent claims 20 and 29 are distinguishable over the combination of Garfinkle and Subramaniam. For at least due to the dependency thereon, claims 21, 22 and 30 are also distinguishable over the combination of Garfinkle and Subramaniam.

Applicants respectfully request that the rejection of claims 21, 22 and 30 based on Garfinkle and Subramaniam be withdrawn.

§ 103 REJECTION – GARFINKLE

Claim 25 stands rejected under 35 USC 103(a) as allegedly being unpatentable over Garfinkle. Applicants respectfully traverse.

It is noted that claim 25 depends from independent claim 20. It has been demonstrated above that claim 20 is distinguishable over Garfinkle. For at least due to the dependency thereon, claim 25 is also distinguishable over Garfinkle.

Applicants respectfully request that the rejection of claim 25 based on Garfinkle be withdrawn.

§ 103 REJECTION – GARFINKLE, CHUI, HURTADO

Claims 26-28 stand rejected under 35 USC 103(a) as allegedly being unpatentable over Garfinkle in view of Chui et al. (USP 6,657,702) and Hurtado et al (USP 6,611,812). Applicants respectfully traverse.

It is noted that claims 26-28 depend from independent claim 20 directly or indirectly. It has been demonstrated above that claim 20 is distinguishable over Garfinkle. Chui and Hurtado have not been, and indeed cannot be relied upon to correct for at least the above-noted deficiencies of Garfinkle. Therefore, independent claim 20 is distinguishable over the combination of Garfinkle, Chui and Hurtado. For at least due to the dependency thereon, claims 26-28 are also distinguishable over the combination of Garfinkle, Chui and Hurtado.

Applicants respectfully request that the rejection of claims 26-28 based on combination of Garfinkle, Chui and Hurtado be withdrawn.

#### WITHDRAWAL OF FINALITY

In the Non-Final Office Action of March 9, 2005, the Examiner alleges that the recording medium as recited is equivalent to a "computer storage" referring to column 3, lines 56-58 of Garfinkle. *See March 9, 2005 Office Action, item 3.* Then in the Response to Arguments of the Final Office Action of August 8, 2005 section, the Examiner alleges that the film roll (referring to column 4, lines 14-20 of Garfinkle) or the local machine of the photographer (referring to column 4, lines 21-23) can be considered to be the recording medium as recited.

Clearly, the rejections of the previous Office Action and the Response to Arguments are inconsistent. This amounts to applying a new ground of rejection to unamended features. Therefore, the finality of the rejection should be withdrawn.

#### **CONCLUSION**

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to

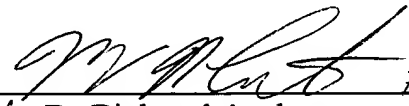
be resolved, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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